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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,169	02/09/2000	William T. Carden Jr.	35672-164254	3485
26694	7590	10/19/2006		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER HILLERY, NATHAN	
			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/501,169	Applicant(s) CARDEN JR., WILLIAM T.	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26, 28-37, 39, 41, 42, 44, 46-55, 57, 59, 60, 62, 64-73, 75 and 77-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 28-37, 39, 41, 42, 44, 46-55, 57, 59, 60, 79-84, 88, 89, 91-94 and 97 is/are allowed.
- 6) ☒ Claim(s) 62, 64-73, 75, 77, 78, 85-87, 90, 95 and 96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>10/4/06</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 7/25/06.
2. Claims 26, 28-37, 39, 41, 42, 44, 46-55, 57, 59, 60, 62, 64-73, 75 and 77-97 are pending in the case. Claims 88, 89, and 90 are independent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 62, 64-73, 75, 77, 78, 85-87, 90, 95 and 96 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yanagiuchi et al. (US 5203001 A).
5. **Regarding independent claim 90**, Yanagiuchi et al. explicitly teach FIG. 3 shows the hardware construction of the portable computer of the present embodiment. The LCD 6, the keyboard 7, a CPU 10, a display controller 11, an I/O device 12, a ROM 13 and a RAM 14 are shown in FIG. 3 (Column 2, lines 64 – 68), which meet the limitation of **a processor (3.10); a memory (3.13, 3.14); and a database (3.12), wherein said memory carries thereon managing and reviewing software, which, when executed by the processor, causes the processor to carry out various steps**, since Yanagiuchi et al. teach that if the program running-start address buffer 14c does not contain the program running-start address data that corresponds to the

definition key input, then the CPU determines that the program has never been executed (Column 3, line 67 – Column 4, line 2).

Therefore, it should be noted that the teachings of Yanagiuchi et al. meet the claim language because the claimed managing and reviewing software resident on a computer system in memory does not have to ever be executed as taught explicitly by Yanagiuchi et al. (Column 3, line 67 – Column 4, line 2). Further, the claim language does not necessarily require execution, since it simply recites, “when executed by the processor” (lines 5 & 6), which as explained above does not have to ever occur. As further evidenced by “Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP 2111.04).

6. **Regarding dependent claims 62, 64-73, 75, 77, 78, 85-87, 95 and 96**, it should be noted that the claims seek to limit the steps taken by the processor only when the software is executed by the processor. Consequently, the claims incorporate substantially similar subject matter as claim 90 and are rejected along the same rationale.

Allowable Subject Matter

7. Claims 26, 28-37, 39, 41, 42, 44, 46-55, 57, 59, 60, 79-84, 88, 89, 91-94 and 97 are allowed.

Response to Arguments

8. Applicant's arguments with respect to claims 26, 28-37, 39, 41, 42, 44, 46-55, 57, 59, 60, 62, 64-73, 75 and 77-97 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH


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